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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/699,051 | 10/30/2003 | Brian R. Reynolds | 1001.1716101 | 1188 |

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EXAMINER

HOEKSTRA, JEFFREY GERBEN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3736

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--|--|--|
| Office Action Summary | Application No. 10/699,051 | Applicant(s) REYNOLDS ET AL. | |
| | Examiner Jeffrey G. Hoekstra | Art Unit 3736 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

1. In response to the amendment filed on 05/26/2006, amended claims 1 and 7 are acknowledged. The current rejections of the claims are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-12 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Rasmussen (EP 0 720 838 A1).

4. For claims 1-12, 21, and 22, Rasmussen discloses a method for manufacturing an intracorporal medical device (10), comprising the steps of:

- (a) providing an elongate core member (7);
- (b) distally or proximally disposing a smooth thermoplastic polymer jacket (25) over said core;

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- (c) winding in tension (the pulling positively recited in column 8 lines 30-35) a coil (8) containing fluorocarbon materials on the outside over said jacket distally or proximally (fluorescing PTFE as positively recited in column 8 lines 6-16 and fluorescing Dymax adhesives as positively recited in column 9 lines 1-5, and column 10 lines 27-41);
- (d) heating (column 3 lines 16-52 and the UV irradiation positively recited in column 8 line 46 – column 9 line 5) said jacket which is effective to relieve tension and capable of heating to appropriately wick/embed said jacket between coil windings via capillary forces (column 8 lines 47-53 and column 9 lines 25-33);
- (e) distally disposing a coating (column 2 lines 30-36) over said jacket/coil member (column 3 line 6 – column 4 line 10 and column 8 line 39 – column 9 line 5); and
- (f) providing an outer surface of the jacket relative to the coil that has desirable flexibility characteristics (column 3 line 7 – column 10 and the adjusting positively recited in column 9 lines 25-33).

5. Claims 1-12 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Burnham (US 4,764,324).

6. For claims 1-12, and 21-22, Burnham discloses a method for manufacturing an intracorporal medical device (10), comprising the steps of:

- (a) providing an elongate core member (34);

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- (b) distally or proximally disposing a smooth thermoplastic polymer jacket (36) over said core wherein said jacket has an outer surface relative the coil having the desired flexibility characteristics (column 1 lines 21-28, column 2 lines 1-6 and lines 46-56, and column 4 lines 14-20;
- (c) winding in tension (42) a coil (38) containing fluorocarbon materials (the radio-opaque dye surrounding the coil as in column 1 lines 45-64) over said jacket distally or proximally;
- (d) heating (40,49) said jacket so as to relieve tension and wick/embed said jacket between coil windings wherein said wicking provides an outer surface of the jacket relative to the coil having the desired flexibility characteristics (the peaked and waffle contour as in column 4 lines 42-53 and column 8 lines 39-47 that is capable of not being smooth;
- (e) distally disposing a coating (44) over said jacket/coil member; and
- (f) providing an outer surface of the jacket relative to the coil that has desirable flexibility characteristics.

Response to Arguments

7. Applicant's arguments with respect to claims 1-12 and 21-22 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGH



MAX F. HINDENBURG
ASSISTANT PATENT EXAMINER
ELECTRONIC CENTER 3700